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TO: Examiner: Tvan Art Unit: 2179 Fax: 1-571- 273-8300

From: Edwin H. Crabtree, Patent Attorney

Date: 3-28-2006

Number of Pages Including This One: 9

Notes: To: Mail Stop AF

Please see the following:

1. 1 page Pre-Appeal Brief Request.
2. 1 page Notice of Appeal.
3. 1 page PTO Credit Card Payment Form.
4. 5 page Pre-Appeal Brief.

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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) Bisque - App | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>March 28, 2005</u> Signature <u>[Signature]</u> Typed or printed name <u>Edwin H. Crabtree</u> | | Application Number 10/041,971 | Filed 1-2-2002 |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided. | | First Named Inventor Matthew L. Bisque | |
| | | Art Unit 2179 | |
| I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>26,720</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | | Examiner Mylinh T. Tran | |
| | | Signature <u>[Signature]</u> Typed or printed name Edwin H. Crabtree | |
| | | Telephone number 303-322-7460 | |
| | | Date 3/28/2006 | |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*. | | | |
| <input checked="" type="checkbox"/> Total of <u>8</u> forms are submitted. | | | |

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Matthew L. Bisque et al.

Serial Number: 10/041,971

Art Unit: 2179

Filed: January 2, 2002

Examiner: Mylinh T. Tran

For: SYSTEM FOR OPERATING AN ASTRONOMICAL OBSERVATORY
OVER A NETWORK

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop- After Final
Commissioner of Patents
P.O. Box 1450
Alexandria, Virginia 22313

Sir:

Responsive to the Office Action mailed December 30, 2005 (hereinafter "the 12/30/2005 Office Action") and the Advisory Action mailed March 1, 2006, and further to the Amendment After Final Rejection filed February 10, 2006, please see the following Pre-Appeal Brief Request for Review.

REMARKS

In the 12/30/2005 Office Action, the Examiner finally rejected (I) claims 1-4, 8, and 9 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2002/0173877 to Zweig (hereinafter "Zweig"); and (II) claims 5-7 and 10-30 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zweig. Applicants traverse these rejections on various grounds, including the following.

I. CLAIMS 1-4, 8, AND 9.

Applicants traverse the rejection of claims 1-4, 8, and 9 under 35 U.S.C. § 102(e) as allegedly being anticipated by Zweig on the grounds that the rejection is improper *at least* because Zweig does not disclose each and every feature of the claimed invention. For example, claim 1 recites *inter alia* the features of "a web browser, said web browser providing means for a user to be able to send requests to an astronomical observatory at an observatory site, and receive the

status and results of these requests by utilizing an http protocol, said web browser further providing a rich graphical interface for the user which may include displays of the status and results of requests made by the user to various components of the system as they occur in real time; [and] a set of astronomical hardware, said set of astronomical hardware being located at the observatory site and supplying means for making celestial observations and for capturing these observations in a digital format so that they may be transmitted to said web browser and displayed for the user." At least this combination of features is not disclosed in the prior art.

The Examiner, in applying the disclosure of Zweig to the claimed invention, has mixed and matched various features from separate and distinct systems described in the disclosure of Zweig to create a combination of features that allegedly anticipates the claimed invention. This modification and combination of the discrete systems described separately in the reference is improper in a rejection under § 102.

For instance, the Examiner asserts that Zweig discloses an apparatus for operating an astronomical observatory to make celestial observations, and capture these observations in a digital format in paragraph 18. See, the 12/30/2005 Office Action at page 2. In actuality, the cited paragraph of Zweig discloses controlling a telescope from a web browser using commands that are written in Astronomical Instrument Markup Language (hereinafter "AIML"). See, Zweig at paragraph 18. However, the described embodiment does not provide all of the features of the claimed invention, such as enabling, via a web browser, displays of real-time status and results of the AIML commands. This may be due in part to the fact that AIML systems typically are not capable of providing real-time results to the browser that is generating the AIML commands.

To provide a teaching of displaying real-time status and results of browser-based commands, the Examiner applies the disclosure of Zweig at paragraphs 11, 12, and 56. These paragraphs describe systems that are distinct and separate from the telescope control apparatus described in paragraph 18. Specifically, these paragraphs describe using Common Gateway Interface

(hereinafter "CGI") to control robotic systems. Paragraphs 11 and 12 discuss various prior art systems that implement CGI, and paragraph 56 describes the use of CGI control in the invention of Zweig. Neither of the systems described in the passages cited by the Examiner explicitly discusses controlling a telescope via CGI, and therefore these systems do not anticipate the claimed feature of controlling astronomical equipment via a web browser.

Thus, the Examiner has impermissibly combined descriptions of robotic control systems described as separate and distinct systems in Zweig in an attempt to formulate a rejection of claim 1 as being anticipated by Zweig. This modification of the systems disclosed in Zweig is improper for the purposes of a rejection under § 102 based on anticipation of the reference. For at least this reason, the rejection of claim 1 is improper and must be withdrawn. Further, claims 2-4, 8, and 9 depend from claim 1. Therefore, the rejection of claims 2-4, 8, and 9 must be withdrawn at least based on their dependency, as well as for the features that they add to claim 1.

II. CLAIMS 5-7 and 10-30.

Applicants traverse the rejection of claims 5-7 and 10-30 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zweig on the grounds that the rejection is improper *at least* because (A) Zweig fails to teach or suggest all of the features of the claimed invention, and (B) there is no motivation to modify any of the systems described in Zweig to provide the combination of features found in the claimed invention.

A. Zweig fails to teach or suggest all of the features of the claimed invention.

Although the Examiner proposes various modifications to Zweig in rejecting claims 5-7 and 10-30 (see, the 12/30/2005 Office Action at pages 5-10), none of the proposed modifications address the deficiencies of Zweig discussed above. Further, in paragraph 19 Zweig teaches away from modifying the described prior art system for controlling a telescope (paragraph 18) using the disclosed mobile robot control system that employs the CGI control set forth in paragraph 56.

Examiner for several of the modifications is "to help the user to control the astronomical observatory through a web server." See *id.* In providing this motivational statement, the Examiner has not cited any direct evidence that it was known in the art at the time of the invention that the modifications would have resulted in enhanced control. See, *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1998). Further, even if the Examiner had provided such evidence, the rejection would still be improper because the motivational statement must focus on the desirability of the proposed combination, and not simply its effects. See, *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed.Cir. 2002)(*citation omitted*). Accordingly, the motivation provided by the Examiner is not legally proper, and these rejections must be withdrawn.

CONCLUSION

Applicants submit the preceding Remarks with the disclaimer that the arguments contained therein are not comprehensive, and that additional arguments regarding the impropriety of the Examiner's rejections exist. Applicants reserve the right to include some or all of these additional arguments in an Appeal Brief, in the event of an unfavorable decision on this Request.

In spite of the limited nature of the arguments presented in this Request, reconsideration and allowance of the application are anticipated in view of the foregoing Remarks. Should the examiner have any questions regarding this amendment it is urged that she contact the undersigned.

Respectfully submitted,

Edwin H. Crabtree 3/28/2006

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